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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,714	03/29/2004	Bakul C. Dave	66391/47280	1446

  

7590	08/23/2007
THOMPSON COBURN LLP	
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EXAMINER	
NAFF, DAVID M	

  

ART UNIT	PAPER NUMBER
1657	

  

MAIL DATE	DELIVERY MODE
08/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/811,714

**Applicant(s)**

DAVE ET AL.

**Examiner**

David M. Naff

**Art Unit**

1657

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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#### **DETAILED ACTION**

An amendment of 6/11/07 amended claims 1-3, 8, 10, 23, 27, 29, 32 and 37.

Claims examined on the merits are 1-37, which are all claims in the application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Objections***

Claim 32 is objected to because of the following informalities: in line 2 "of", second occurrence, should be --- and --- since the hydrophobic group is not of the hydrophilic group. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

Claims 1, 2, 6-10, 12-31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al (5,200,334) in view of Reetz et al (6,080,402).

The claims are drawn to a porous glass composite comprising a gel having a group of alterable charge, a hydrophilic group and a hydrophobic group and containing an alkoxodisilane derivative and water.

Dunn et al disclose producing a sol-gel glass containing a biological material (Fig 1).

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Reetz et al disclose producing a silica matrix for immobilizing an enzyme containing a alkoxodisilane (col 2, line 59).

It would have been obvious to prepare the sol-gel glass of Dunn et al using a alkoxodisilane to obtain the function of the alkoxodisilane as obtained by Reetz et al when preparing a silica matrix. The resultant material can inherently contain a group of alterable charge, a hydrophobic group and a hydrophilic group. The limitations of dependent claims would have been a matter of obvious choice within the skill of the art in view of the disclosures of the references.

#### ***Response to Arguments***

The amendment refers to a previously filed Affidavit of Dr. Dave. However, this application does not contain a previous affidavit. In any event, the claims do not exclude hydrolysis that may occur in Reetz et al. Claim 1 does not require an alkoxosilane, per se, but requires a derivative of the alkoxosilane. The derivative can be a hydrolysis product. The groups of claim 1 can be in the sol-gel glass of Dunn et al from sources other than the alkoxodisilane such as additives or biological material added.

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### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 2, 3 and 32 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17, 18 and 19 of prior U.S. Patent No. 6,756,217. This is a double patenting rejection.

### ***Double Patenting***

Claims 1-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,756,217 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed porous glass composite encompasses the porous glass composite of the patent claims

### ***Conclusion***

Claims 3-5, 11 and 32-36 are free of the prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is 571-272-0920. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David M. Naff  
Primary Examiner  
Art Unit 1657

DMN

8/21/07